

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-10 are pending in the present application.

In the Official Action, Claims 1-10 were rejected under 35 U.S.C. § 112, second paragraph; Claims 1-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki et al. (U.S. Patent No. 6,936,388, hereinafter “Suzuki”) in view of Maxwell (U.S. Patent No. 3,948,656); Claims 1-10 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kami et al. (U.S. Patent Publication No. 2003/0013642, hereinafter “Kami”); and Claims 1-10 were provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over Claims 1-26 of copending application Serial No. 10/135,548.

Regarding the double patenting rejection, Applicants submit it is premature to respond until one of the two applications in question are in condition for allowance.

Applicants traverse the rejection under 35 U.S.C. § 112, second paragraph and note that the originally filed specification discloses suitable materials for use as the claimed electroconductive substrate.¹ Furthermore, Applicants describe the claimed photosensitive layer of the photoreceptor in the specification.²

Applicants request acknowledgement of the IDS of March 19, 2004.

Applicants file herewith a declaration under 37 C.F.R. § 1.132 regarding the Kami reference, thus rendering moot the rejection of Claims 1-10 under 35 U.S.C. § 102(e).

Applicants provide herewith an accurate translation of priority document JP 2003-076650, thus perfecting Applicants’ claim to a priority date of March 13, 2003.

¹ Specification page 37, line 26 through page 38, line 14.

² Specification page 39, line 15 through page 42, line 18.

Regarding the rejection under 35 U.S.C. § 103(a) in view of Suzuki and Maxwell, because Suzuki (filed in the U.S. on March 25, 2002) was published in the U.S. on April 24, 2003, which is after Applicants' now perfected priority date of March 19, 2003, Suzuki is not a reference under 35 U.S.C. § 102(a) or 102(b). The invention of Suzuki was described in an application for patent, published under § 112(b), by another filed in the United States before the invention by the Applicants for patent. Thus, Suzuki is a reference under 35 U.S.C. § 102(e). However, because the subject matter of Suzuki and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to obligation of assignment to the same person, Suzuki should not preclude patentability under 35 U.S.C. § 103(a) in view of the provisions of 35 U.S.C. § 103(c).

Of the five Japanese priority documents listed on the face of the Suzuki patent, JP 2002-040962 was published as Japanese Application 2002-351113 on December 4, 2002, which is before Applicants' now perfected priority date of March 13, 2003. However, the portions of Suzuki relied upon in the rejection are not described in JP 2002-040962. Furthermore the subject matters of JP 2001-084942, JP 2001-125371 and JP 2002-050316 were published jointly in Japanese Application 2003-322989 on November 14, 2003, which is after Applicants' now perfected priority date of March 19, 2003. Thus, none of the five Japanese priority documents listed on the face of the Suzuki patent are prior art to the Applicants' invention.

Accordingly, in view of the present amendment and in light of the previous discussion, Applicants respectfully submit that the present application is in condition for allowance and respectfully request an early and favorable action to that effect.

Respectfully submitted,

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